

2012

Report of the Council for Research on Proposed Revised Intellectual Property Policy.

University of Rhode Island Faculty Senate

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THE
UNIVERSITY
OF RHODE ISLAND



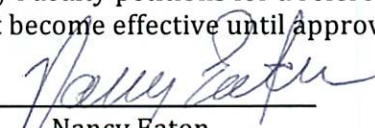
Serial Number #11-12--17

TO: President David Dooley

FROM: Nancy Eaton, Chairperson of the Faculty Senate

1. The attached BILL titled, Report of the Council for Research on Proposed Revised Intellectual Property Policy (as amended), is forwarded for your consideration.
2. This BILL was adopted by vote of the Faculty Senate on March 22, 2012.
3. After considering this bill, will you please indicate your approval or disapproval. Return the original or forward it to the Board of Governors, completing the appropriate endorsement below.
4. In accordance with Section 10, paragraph 4 of the Senate's By-Laws, this bill will become effective April 12, 2012, three weeks after Senate approval, unless: (1) specific dates for implementation are written into the bill; (2) you return it disapproved; (3) you forward it to the Board of Governors for their approval; or (4) the University Faculty petitions for a referendum. If the bill is forwarded to the Board of Governors, it will not become effective until approved by the Board.

March 26, 2012
(date)


Nancy Eaton
Chairperson of the Faculty Senate

ENDORSEMENT

TO: Chairperson of the Faculty Senate

FROM: President of the University

Returned.

a. Approved ☒.

b. Approved subject to final approval by Board of Governors ☒.

c. Disapproved ☐.

5.1.12
(date)


President

Approved 4/8/13

**UNIVERSITY OF RHODE ISLAND
FACULTY SENATE
COUNCIL FOR RESEARCH
REPORT ON PROPOSED REVISED
URI INTELLECTUAL PROPERTY POLICY
As amended on March 22, 2012**

Summary of Changes

- IP Policy provides easy to read policy and guidelines for Intellectual Property including patents, trademarks, and copyrights.
- IP Policy recognizes Bayh-Dole, URI and Federal Conflict of Interest policies and other Federal, State and URI policies.
- Creator user-friendly approach to assist in protecting URI IP.
 - IP Management and Commercialization (IPMAC) office assists inventor in all aspects of the process. Also, IPMAC will assist in reviewing IP agreements.
 - IPMAC reviews invention with Creator and assists in filling out an Invention Disclosure form.
 - IP Committee has more active involvement in decisions, which include 3 categories - accept, return to Creator or provisional acceptance.
 - New role for Deans in the decision process to agree or disagree with IPC decisions. Includes equal IP cost sharing with URI Research Foundation (URIRF) in excess of URI paid IP costs.
 - Dean and Creator may work with URIRF to protect IP if not approved by IPC.
- Increased royalty rates for inventors, recognizing most inventions produce royalties \$25,000 or less. Only IP costs and fees are deducted.

Patent IP Distribution Schedule

Cumulative Net Royalties	Inventor	College & URIRF
\$25,000 or less	40.0 %	30.0 %
Above \$25,000	35.0 %	32.5 %

- Added flexibility for Creator to form companies assisted by URIRF or to commercialize with external parties. Creator may choose between equity ownership or royalties if a company is formed.
- URI owns copyrights only if substantial university resources are used. Only Cumulative Net Royalties in excess of \$10,000 are collected and dispersed on revenue.

Patent IP Distribution Schedule

Cumulative Net Royalties	Inventor	College & URIRF
\$10,000 or greater	60.0 %	20.0 %

- Trademarks licensing follows copyright policy unless licensed with a patent.
- Clear definitions are provided at the end.

UNIVERSITY OF RHODE ISLAND INTELLECTUAL PROPERTY POLICY

I. General Principles.

- a. The University of Rhode Island (hereinafter "Institution") encourages and promotes research and scholarship based on the traditional principles of the academic profession. Some discoveries, advancements, and innovative approaches may have the potential to be further developed into products or services that have utility beyond the Institution and that may positively impact the economy of Rhode Island. Through this Policy, the Institution seeks to define and execute a synergistic model of education, research, service, innovation, commercialization, and economic development and to apply this model to help solve significant problems of a complex world.
- b. The primary purposes of this Policy are to:
 1. Provide clear guidelines for all parties involved in the creation, development, management, protection, commercialization, licensing and dissemination of intellectual property.
 2. Provide for an effective, efficient process to achieve positive outcomes for creators, Colleges, Institution, and society.
 3. Recognize, respect, and effectively manage all interests that may emerge from discoveries that have commercial or other valued outcomes and provide guidance for intellectual property protection and commercial development.
 4. Bring technology into practical use for the public benefit as quickly and effectively as possible, in a manner consistent with applicable law and policy.
 5. Facilitate the creation of appropriate public-private partnerships in order to achieve commercialization, utilization, and economic development.
 6. Encourage a broad array of mutually beneficial relationships with organizations outside the Institution to further develop discoveries made at the Institution, including: collaborative research; licensing of Intellectual Property (IP); and the establishment of companies and other entities specifically formed to commercialize IP created at the Institution.
 7. Develop a process to work integrally with the URI Research Foundation (herein after URIRF) for the marketing and commercialization of Institution inventions and innovations and for fostering economic development in the State of Rhode Island.
- c. This Policy governs unless a specific policy or agreement provides otherwise.
- d. This Policy shall be administered in accordance with, and subject to, policies of the Institution concerning IP and its requirement under the Bayh-Dole Act and Federal and State Conflicts of Interest (COI), academic misconduct and other applicable laws and regulations.

- e. Any Creator of a Copyrightable Work, Invention, Trade Secret, Trademark, Tangible Research Property, or other IP should contact the Institution Office for Intellectual Property Management and Commercialization (IPMAC).

II. General Intellectual Property Policy.

- a. The Institution strongly encourages its faculty, staff, and others associated with the Institution to pursue formal protection and/or commercialization of all IP as a method of bringing recognition and/or remuneration to the Creators and the Institution.
- b. Intellectual Property may arise from the development of a new and useful process, device or apparatus, article of manufacture, design, composition of matter (including, but not limited to, a chemical compound, microorganism, nucleotide sequence, amino acid sequence, equipment, device, genetically engineered organism, and the like), plant, or related improvement, or a new use for a known material or device or related improvement. This class of IP will be considered as Patent IP, which includes patent applications and Plant Variety Protection. In addition, other intellectual property under the Copyright IP may include written material, spoken description, sketches, musical scores, sculptures, and paintings. Software code will be considered under Copyright IP and/or Patent IP. Trademarks will be considered separately under Trademarks IP. Any individual who is uncertain should contact the IPMAC Office and request guidance.
- c. Except as set forth herein, all rights to and interests in any IP resulting from research or investigation conducted in the course of the Creator's employment with the Institution (including, but not limited to, the performance of a grant, contract, or award made internally, by an extramural agency, or by a third party) or with the Creator's Significant Use of the Institution's Resources shall be the sole and exclusive property of the Board of Governors for Higher Education (BGHE) and its designee, unless specified otherwise by a prior written agreement. Unless approved by the Vice President for the Division of Research and Economic Development (DRED), no other person or entity shall have joint or shared rights of ownership or interest in such IP.
- d. Creator will provide any and all required declarations, assignments, and other documents in the course of processing IP.
- e. Unless otherwise provided by law or a prior written agreement, this Policy applies to any IP made by the Institution's faculty, staff, students, trainees, volunteers or others if such IP is the result of:
 - 1. Any IP developed by or under the direction of any faculty, staff, or student, the cost of which was partially or wholly paid for with funds under the control of or administered by the Institution; and/or
 - 2. Any IP developed by the faculty, staff, students, trainees, volunteers, or others utilizing the Institution's facilities, laboratories, or other resources available to such faculty, staff, students, trainees, volunteers or others

because of their status within the Institution.

III. Patent Intellectual Property Policy

- a. Patent IP is defined as Intellectual Property arising from the development of a new and useful process, device or apparatus, article of manufacture, design, composition of matter (including, but not limited to, a chemical compound, microorganism, nucleotide sequence, amino acid sequence, equipment, device, genetically engineered organism, and the like), plant, or related improvement, or a new use for a known material or device or related improvement, or a new use for a known material or device. Patent IP will include a patent application and Plant Variety Protection. A Creator of Patent IP will be considered an Inventor under Patent IP Policy.
- b. Patent IP conceived or developed in the furtherance of research or investigation conducted by the Institution's faculty, staff, students, trainees, volunteers, or others in section II(e) above, shall be promptly disclosed in writing to the IPMAC Office. After consultation with the IPMAC Office, the Inventor may be asked to complete and file an Invention Disclosure form provided by the IPMAC Office.
- c. All rights to and interests in any Patent IP arising in the course of research or investigation sponsored by the Institution, any government or private agency, or other sponsored research are controlled by the terms of the applicable IP agreement, which must be reviewed, negotiated, and approved by the IPMAC Office. In the absence of provisions to the contrary contained in any such research or investigation agreement or under federal law or regulations, the following shall apply:
 1. The Inventor has the right to:
 - i. Receive notice of the Institution's intention to protect Patent IP or otherwise to retain title to the IP after the IP Disclosure is made to the Institution within six (6) months or as otherwise prescribed by laws;
 - ii. Receive a share of any Licensing Revenue, such as licensing fees or royalties, received by the Institution from the commercialization of the Invention according to the appropriate Distribution Schedule contained under this section; and
 - iii. Receive from the Institution title to any Patent IP subject to this Policy in the event the Institution elects not to retain the same.
 2. The Inventor is required to:
 - i. Promptly file an IP Disclosure including the name of any co-Inventor;
 - ii. Assign ownership of the Patent IP to the BGHE and its designee;
 - iii. Cooperate to the extent necessary as determined by the Institution in the reasonable delay of publication to allow for a timely submission of a patent application;

- iv. Cooperate in protecting any Patent IP;
 - v. Participate in the defense of such patents during prosecution for interference or infringement; and
 - vi. Assist with licensing or marketing efforts related to the Patent IP.
3. The BGHE and its designee has the right to:
- i. Assign its rights to the Inventor, up to and including full ownership, in any Patent IP subject to this Policy to which the BGHE and its designee choose not to retain title;
 - ii. Assign at any time by the President, or designee, the rights or interests of any Patent IP owned by the BGHE and its designee to an Affiliated Foundation whereby the URIRF is the sole Affiliated Foundation recognized to receive Patent IP; or
 - iii. Retain non-commercial research rights to any Patent IP developed by the Institution.
4. The Institution is obligated to:
- i. Provide adequate resources to fulfill and meet the obligations in the Patent IP Policy and comply with the Bayh-Dole Act and other applicable laws;
 - ii. Make faculty, staff, students, trainees, volunteers or others aware of the Patent IP Policy and of any ongoing agreements with external sources to evaluate and/or market such IP;
 - iii. Determine, after the IP Disclosure is filed, whether the Institution chooses to retain title and to protect the Patent IP and give notice of Institution's intention to protect the Patent IP to the Inventor within six (6) months or as otherwise prescribed by laws;
 - iv. Expedite formal Patent IP protection procedures; and
 - v. Distribute Licensing Revenue received by the Institution for any Patent IP according to the appropriate Distribution Schedule contained herein.
- d. The distribution of royalties and other licensing revenue, such as licensing fees, milestone payments or equity, received by the Institution or URIRF for exclusive licenses or assignments shall be distributed according to the following considerations. There are numerous interests involved in connection with research and innovation performed at the Institution, including the researcher and Inventor; the Institution; the general public whose taxes and gifts support the Institution; and outside entities that provide support. Subject to restrictions arising from obligations of the Institution or URIRF pursuant to gifts, grants, contracts, or other agreements with outside organizations, the Institution or URIRF agrees, for and in consideration of the licensing or assignment of Patent IP rights, to pay Cumulative Net Royalties according to the Distribution Schedule below for Patent IP licensed or assigned by the Institution or URIRF.

Patent IP Distribution Schedule

Cumulative Net Royalties	Inventor	College	URIRF
\$25,000 or less	40.0 %	30.0 %	30.0 %
Above \$25,000	35.0 %	32.5 %	32.5 %

When there are two or more Inventors, each Inventor shall share equally in the Inventor's share of Cumulative Net Royalties, unless all Inventors have agreed in writing to a different distribution of such share. Likewise, where there are two or more Colleges involved, each College shall share equally unless otherwise agreed in writing. The VP DRED shall have final authority in resolving disputes between Inventors and Colleges as to the sharing of royalties between them.

- e. Cumulative Net Royalties received by the URIRF and the Colleges must be used to support research and to further the development, commercialization and/or protection of any IP. To this end, Institution shall reward its employees for creating Patent IP and participating in commercialization activities, assist faculty and staff in the commercialization of their products, support related programs, support additional research in the laboratories and programs that generated the Patent IP, and support the protection of new discoveries.
- f. The Inventor obligations under section III(c)(2) and Institution obligations under section III(c)(4) do not terminate upon separation of employment from the Institution.
- g. Intellectual Property Protection Procedure. Unless otherwise indicated, the VP DRED, or designee, is responsible for the administration of this Policy. The IPMAC Office is responsible for the administration of the Patent Protection Procedure, the oversight of financial rights, negotiations and for management of Patent IP records. This Patent Protection Procedure serves as a guide to the Institution community in meeting the disclosure and reporting requirements of the Institution, BGHE, and cooperating agencies.
 - 1. Intellectual Property Agreement Review. Prior to executing any contract that binds the Institution or one or more Inventors with regards to Patent IP, such contract will be submitted to the IPMAC Office, who may consult with the Institution General Counsel, to ascertain that IP clauses in sponsored projects are acceptable to the principal investigator and the Institution and are consistent with policies of the BGHE, and if appropriate, with federal law. Such agreements include confidentiality, non-disclosure, material transaction, consulting, and like agreements containing provisions for proprietary information and contractor sponsored research or development, licensing, or like agreements containing provisions for any Patent IP.
 - 2. Documentation and Tracking. Inventors are responsible for recording and maintaining the discovery records of all potentially patentable discoveries derived through Institution activity. Subject to America Invents Act effective

March 16, 2013, bound, dated, witnessed documentation is the encouraged method for maintaining such records. Inventors shall discuss with the IPMAC Office the proper method for maintaining records.

3. **Intellectual Property Disclosure.** An Inventor shall meet with the IPMAC Office and disclose the actual or prospective Patent IP at the earliest possible time after its creation. After consultation with IMPAC Office, the Inventor may be asked to complete and submit an Invention Disclosure describing the Invention. In the case of Inventions, the Inventor is encouraged to submit an IP Disclosure to the Institution at least ninety (90) days prior to any enabling Public Disclosure. An Invention Disclosure should be made on a form provided by the IPMAC Office or prepared in conjunction with the IPMAC Office. If the Invention Disclosure is deemed adequate, the IPMAC Office will assign a unique Institution identifier. The IPMAC Office will have sole discretion to determine whether the IP Disclosure is sufficient. If not on file, the Inventor shall assign ownership rights to BGHE and its designee. Upon receipt of an Invention Disclosure, the IPMAC Office will notify within a reasonable period of time, if necessary, the appropriate federal agency providing grant support of the Disclosure, in compliance with 37 CFR Part 401 and 35 U.S.C. sections 200-212.
4. **IPMAC Office Evaluation.** The IPMAC Office will review each Invention Disclosure before committing Institution resources or other funds in the pursuit of a patent, protection of a trade secret, protection of copyright or any other form of protection of any IP. Such an evaluation should consider all aspects of any IP, prior art search and assessment, market potential, prospective licensees, financial return, obligations to sponsoring parties, and other factors impacting the investment of time and funds to complete the IP protection process. This review may entail the commissioning of market, patentability, or similar studies at the sole discretion of the IPMAC Office. Upon review, the IPMAC Office will advance Invention Disclosure to the IP Committee for review, unless additional research or investigation is required.
5. **Intellectual Property Committee Review.** The IP Committee will review the Patent IP with the Inventor and make one of three recommendations. If necessary, the IPC will prioritize the filing patent applications in the case of an Invention. The three recommendations are: accept to protect IP; provisional acceptance pending additional work or review of prior art; or return rights to the Inventor.
6. **Notification of the College.** The recommendation of the IPC will be submitted to the Dean of the Inventor College for their review. The Dean may agree with the recommendation or disagree with the recommendation. If the Dean disagrees with the recommendation to protect the Patent IP, then the URIRF may pay for all the Patent IP costs and the Colleges will not receive any royalty distribution. If the Dean disagrees with returning the IP rights to the Inventor, then the College may be responsible for all IP costs, unless the URIRF agrees to share 50% of the IP costs with the College. In

the case where the College pays all patent costs, it will receive the URIRF Cumulative Net Royalties share.

7. Final approval by the VP DRED. Upon determination that Institution will not pursue protection of IP, and no later than six (6) months after receipt of the Invention Disclosure all rights in the IP will be returned to the Inventor. Institution shall execute one or more assignments to the Inventor to effect this reversion.
8. Patent IP Application. Upon approval by the Institution to pursue protection of an Invention, the IPMAC Office will:
 - i. Notify, if necessary, the appropriate federal agency of the Institution's desire to retain title to the invention;
 - ii. Work with Inventor to file a patent application or PVP on the Invention; and
 - iii. File a patent application either directly or with an external service provider within the appropriate period.
9. Intellectual Property Costs. The Institution shall be responsible to pay an annual amount toward the total annual cost of Patent IP protection and maintenance. For Patent IP costs greater than the Institution annual allocation, URIRF and the Colleges will equally share the costs for the year as follows. In a fiscal year, Colleges having 5 or more patent applications in prosecution or issued patents will pay at rate of 1 unit. Colleges having 1-4 patent applications in prosecution or issued patents will pay at rate of 0.2 unit. College share for the fiscal year will be determined by dividing their unit by the sum of all units in that year times one-half of the unpaid Patent IP costs.
10. Documentation. As necessary to protect the interests of the Inventor and the Institution, and as allowed by law, the records supporting IP protection and appropriate documents with any commercialization organization will be maintained as confidential. The official IP file shall contain the following items, if applicable:
 - i. Documentation identifying the sources of funds used to cover costs.
 - ii. The costs of Patent IP protection and maintenance. In the event that third party reimbursed for prosecution or related IP costs, Institution's costs will be reduced accordingly.
 - iii. Contract or grant terms and conditions under which the IP was conceived or developed.
 - iv. Initial records of invention (i.e. notebook references, drawings, sketches, etc.) and formal records of invention required by sponsors.
 - v. IP Disclosure documents submitted by the Inventor.
 - vi. Assignments and other agreements relating to the transfer of ownership.

- vii. Documentation of the recommendation of the IPC and the written notice by the VP DRED to either protect the Patent IP rights or to return the Patent IP rights to the Inventor and the cost of Patent IP protection.
 - ix. Patent IP application(s), as filed.
 - x. Any agreements related to the licensing of the Patent IP rights.
 - xi. Issued or registered Patent IP rights.
 - xii. Licenses, equity positions, or other commercialization documents or agreements that specify the financial returns to the Institution or URIRF.
 - xiii. Documentation reflecting abandonment of any Patent IP by the Institution, as well as any agreements transferring title back to the Inventor.
11. Commercialization. Upon the decision to pursue commercialization of Patent IP, the IPMAC Office or URIRF shall outline a commercialization plan in cooperation with the Inventor. The commercialization may include licensing to a company including licensing to a company started by the Inventor.
12. Intellectual Property Assignment and/or Licensing. At any time subsequent to the disclosure of Patent IP to BGHE or its designee, the rights, title and/or interest therein may be licensed or assigned to one or more third parties. In the case of assignments, only the President of the Institution, or a designee, may sign appropriate documentation affecting the same.
- i. The Institution authorizes the IPMAC Office to establish a means of administering and managing the Institution's Patent IP assets that (1) expedite their commercialization, (2) provide means for the defense of Patent IP, (3) maintain the secrecy of Patent IP when necessary, and (4) provide financial returns to the Inventor and the Institution. For commercialization of Patent IP not assigned to URIRF, the IPMAC Office will be responsible for negotiating and approving all agreements relating to the assignment of Patent IP rights. Authority to sign licensing or like agreements on behalf of the Institution shall be vested in the IPMAC Officer and the VP DRED, and their designees.
 - ii. At its sole discretion, the BGHE or designee may assign or transfer ownership rights in Patent IP to the URIRF, in which case URIRF will assume obligations under this section III, as appropriate, and provide timely documentation to the Institution in addition to complying with any formal agreement between the Institution and the URIRF.
 - A. The URIRF may request that the BGHE or designee transfer specific Patent IP rights for patenting and commercialization activities. Such a request should be in writing and made to the IPMAC Office.
 - B. When appropriate, Institution and URIRF will have confidentiality agreements to cover the exchange of information.

- C. If the Patent IP was supported directly or indirectly by a federal agency, prior to assignment the Institution will obtain documents showing that the Patent IP has been assigned to the BGHE or designee by the Inventor and the Institution has disclosed and elected to retain title therein to the supporting agency.
 - D. If URIRF funds commercialization, product development, and/or research at the Institution for the advancement of Patent IP, the Institution shall not charge any indirect cost rate unless agreed otherwise.
 - F. Upon transfer of Patent IP to an URIRF, Institution will provide copies of all Patent IP documents to the URIRF, including original file wrappers, agreements, and related documents.
 - G. When the BGHE or designee has transferred Patent IP to an URIRF, subject to restrictions arising from obligations of the Institution pursuant to gifts, grants, contracts, or other agreements with outside organizations, URIRF will, for and in consideration of the assignment of Patent IP rights, pay Cumulative Net Royalties under the Distribution Schedule III(c):
 - iii. It is the responsibility of the employee and College to provide the IPMAC Office or URIRF with any and all relevant IP agreements, which include consulting, confidentiality, MTA, licensing and research agreements, to ensure that the term of the agreement with third parties do not conflict with their commitment to the Institution. Each employee shall make the nature of the employee's obligations to the Institution clear to any third party for whom the employee expects to consult. Specifically, the scope of the consulting service must be distinguished from the scope of research commitment to the Institution. This subsection shall comply with and be subject to any Federal, State or Institutional laws or policies regarding Conflict of Interest.
13. Formation of New Company with Inventor as an Owner. After transferring rights to the URIRF, the URIRF may license or assign, if the assignment has been transferred, the IP rights to the New Company owned by the Inventor in exchange for licensing fees and royalty or an equity share in the New Company.
- i. The Inventor will be required to undergo a Conflict of Interest evaluation by the Institution and, if necessary, receive approval by the BGHE.
 - ii. In the case where URIRF has an equity share in the New Company, URIRF share will be at least 10% unless agreed otherwise.
 - iii. The Inventor will be allowed to choose between an equity ownership of the Company or their Distribution Share of the Cumulative Net Royalties received from the New Company but not both. In the event that Inventor forgoes receiving their Distribution Share of the Cumulative Net Royalties, URIRF and the College will receive 50% of Cumulative Net

Royalties.

14. **Cumulative Net Royalties Distribution.** Unless assigned to an URIRF, the IPMAC Office will be responsible for the collection of all Licensing Revenue and the payment of all Costs of Patent IP Protection and the distribution of Cumulative Net Royalties under section III(d) upon approval by the VP DRED. In the case of IP assigned to URIRF, URIRF will distribute Cumulative Net Royalties as set forth in under section III(d). Documentation of the distribution of licensing revenue to the Inventor, Institution, any cooperating agencies, and other parties will be provided upon request by the IPMAC Office or URIRF.
15. **Intellectual Property Documents.** The IPMAC Office shall maintain a filing and storage system for all original Patent IP documents and any and all IP agreements that is consistent with Institution's record retention policy.
16. **URIRF may not enter into an agreement to sell, transfer, or otherwise dispose of any ownership rights in Patent IP to any third party without the express, written permission of the President of the Institution or BGHE, unless IP rights have been transferred to URIRF. Any request for such permission shall include, at a minimum, a comprehensive description of the asset to be transferred, the identity of the proposed transferee, a statement of the purpose of the proposed transaction, and a statement of the benefit to the Institution to be derived from the proposed transaction.**

IV. *Copyright Intellectual Property Policy.*

- a. Except as otherwise explicitly provided under this Policy or a Copyright Agreement, an employee who creates a Work shall be deemed to acquire copyright ownership of the Work, unless Significant Use of Institutional Resources is made. Under the Copyright IP Policy, Works may include written material, software, code spoken description, sketches, musical scores, sculptures, and paintings and a Creator of the Work will be considered an Author. In keeping with this Policy and with academic custom, except as otherwise provided under this Policy, the Institution shall forever disclaim its copyright ownership in a Work for Hire in favor of the Author, and when deemed necessary, the BGHE or its designee shall execute one or more assignments conveying such copyright ownership to such Author.
- b. Copyright ownership of Work developed as a result of Work supported partially or fully by an outside agency through a contract or grant shall be determined in accordance with the terms of the contract or grant. In those cases in which copyright ownership is vested in the BGHE or its designee, the Institution shall have the first option to secure copyright in the name of the Institution. Should the Institution decide, in writing, not to secure copyright, the employee then may proceed to personally secure the copyright. The BGHE or its designee shall then execute one or more assignments conveying such copyright ownership to such Author.

- c. **Self-initiated Mediated Courseware.** When an employee develops Mediated Courseware without specific direction by the Institution, unless otherwise agreed, the ownership of copyright in the Mediated Courseware shall be deemed to vest in the employee. In the case that such Mediated Courseware is a Work for Hire by a third party, the Institution shall forever disclaim its copyright ownership in favor of the Author, and when necessary, the BGHE or its designee shall execute one or more assignments conveying such copyright ownership to such Author. Normally, no royalty, rent, or other consideration shall be paid to the employee when that Mediated Courseware is used for instruction at the Institution and such Mediated Courseware shall not be used or modified without the consent of the employee. While the Author is employed by the Institution, the Mediated Courseware shall not be sold, leased, rented or otherwise used in a manner that competes in a substantial way with the for-credit offering of the Institution unless approved by the Provost for Academic Affairs of the Institution. The Institution shall have a perpetual, non-exclusive, royalty-free right to use such courseware for archival research purposes. In the event that Significant Use of Institution Resources are used to develop or improve Mediated Courseware, the Author shall be required to obtain approval to use the Mediated Courseware outside of the Institution and the provisions of section IV(b) of this Policy shall apply.
- d. **Institution-directed Mediated Courseware.** When the Institution directs in a written employment contract or Copyright Agreement the creation of specific Mediated Courseware, copyright in the resulting Mediated Courseware belongs to the BGHE or its designee and the Institution shall have the exclusive right to revise it and decide who will utilize the Mediated Courseware in instruction. Pursuant to this subsection, insofar as the Mediated Courseware is a Work for Hire, the BGHE or its designee shall retain copyright ownership. Development of Institution-directed Mediated Courseware shall be reported to appropriate administrator(s) at the Institution.
- e. Unless otherwise specified by this Policy, the Licensing Revenue received in excess of \$10,000 as a result of copyright ownership by the BGHE or its designee will be disbursed as follows; 60% to the Author, 20% to the College and 20% to URIRF.
- f. When the Author creates a Work involving Significant Use of Institutional Resources and if the Licensing Revenue is in excess of \$10,000, the following steps should be followed to determine Copyright Ownership between the Author and the BGHE or its designee:
 - 1. The Author will initiate the process by delivering a copy of the Work and complete and submit the completed Intellectual Property Disclosure to the IPMAC Office.
 - 2. The IPC will make a recommendation regarding Copyright ownership to VP DRED.
 - 3. If the BGHE or its designee has Copyright ownership, then a Copyright Agreement will be entered into between the Author and the VP DRED on

behalf of the Institution or URIRF.

- i. Only if requested, Institution shall be responsible for copyright registration of Work owned by the BGHE or its designee, and for administering contracts with its Author, including the responsibilities associated with maintaining records for copyright registration, royalty collection and distribution, marketing, and such other actions as are appropriate. Institution and Author shall cooperate in the pursuit of copyright protection.
- ii. In all other cases, Author will assume the responsibilities associated with maintaining records for copyright registration, royalty collection, marketing, and such other actions as are appropriate.

V. *Trademark Intellectual Property Policy*

- a. The URIRF or BGHE or its designee shall be listed as the owner of any trademark or service mark for which an application for registration is filed, unless an agreement is to the contrary. Trademarks and service marks shall be filed, prosecuted, registered, and maintained by the Institution at the Institution's expense.
- b. URIRF's or Institution's preference will be to secure federal trademark and service mark registrations, but the Institution reserves the right to secure one or more state registrations.
- c. URIRF or BGHE or its designee may license to a third-party rights in one or more trademarks or service marks owned by or BGHE or its designee. Any such license must at minimum reserve to the URIRF or Institution, the express right to monitor and supervise the use of the mark by licensee.
- d. Trademarks developed by faculty, students, staff or others of the Institution shall, where practicable, be treated in the same manner as other forms of IP. In order to be recognized as a Creator of a trademark, one or more faculty members, students, or staff or others must submit a written statement of creation to the IPMAC Office, preferably before the mark is first used by the Institution but no later than six (6) months after an application to register the mark is filed by Institution. A statement of creation must set forth the identity and contact information of each Creator, a detailed description of the mark, the circumstances of the creation, and the goods and/or services of Institution to which the mark applies or could apply. A separate statement must be submitted for each mark.
- e. Revenue generated through commercialization of goods or services, including technology, under one or more trademarks owned by the BGHE or its designee that is attributable solely to such trademark(s), such as trademark licensing fees and royalties, shall be deemed Cumulative Net Royalties and distributed under the Copyright Intellectual Property Policy, IV(e), for purposes of this Policy.
- f. In no instance, and regardless of ownership, may the Institution's Trademarks or identity be used, expressly or impliedly, in connection with the endorsement

of any Trademark IP. For purposes of this sub-section, "identity" shall include full or partial names or identifiers, physical addresses, Internet or web addresses, trademarks, service marks, logos, emblems or seals. Assignments, license agreements, and other transfers of rights or ownership in any Trademark IP to third parties shall include this limitation.

VI. Definitions.

- a. "Affiliated Foundation": An Affiliated Foundation is a third party organized as a nonprofit entity as described in section 501(c)(3) of the Internal Revenue Code of 1986, that has as one of its primary functions the management of Institution IP and that receives Licensing Revenue and gifts, and supports or promotes the Institution or Institution research under 37 CFR Part 401 and 35 U.S.C. sections 200-212. URI Research Foundation (hereinafter "URIRF") is the sole Affiliated Foundation, unless deemed otherwise by BGHE or its designee.
- b. "Author": A person who creates a Copyrightable Work.
- c. "Copyright Agreement": A written and signed agreement between the Author and the Institution that explicitly defines: the ownership of the Copyrightable Work, any control rights in cases of Mediated Courseware, any reimbursement for Significant Use of Institutional Resources, and/or the sharing of royalties.
- d. "Copyrightable Work" or "Work": An original Work by an Author which has been fixed in a tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device, such as books, journals, software, computer programs (including source code), musical Work, dramatic Work, videos, multimedia products, sound recordings, pictorial and graphical Work, etc. Any Copyrightable Work that is also an Invention shall be governed by the Patent Intellectual Property Policy. A Work may be the product of a single Author or a group of Authors who have collaborated on a project. See *also* Intellectual Property.
- e. "Costs of IP Protection": The expenses incurred by the Institution in conducting the research and in procuring, protecting, preserving, maintaining, and licensing IP and related rights. This includes the costs of securing patent, copyright, or trademark protection in the United States and any foreign jurisdiction.
- f. "Creator": A person who contributes to the development of IP at the Institution in a significant manner and who under this Policy is entitled to the distribution of proceeds from commercialization. For purposes of this Policy, wherever practicable, Creator shall be deemed to include the estate of any deceased person.
- g. "Cumulative Net Royalties": The cumulative lifetime gross revenues obtained from royalties, licensing or assignment fees, and/or the proceeds from the sale of equity, and/or the direct proceeds from Institution practicing its own IP, less external expenses incurred by the Institution or URIRF in procuring, protecting, preserving, and maintaining IP rights, including legal fees associated with the

IP, fees for patentability searches, fees arising out of litigation, fees for legal advice, or any fees or costs directly attributable to the IP being licensed. Marketing and indirect costs, overhead, or other Institution costs usually associated with operation of the Institution and not directly attributable to the IP will not be deducted from gross revenues.

- h. "Entrepreneurial Leave". A Creator may request entrepreneurial leave to pursue their leadership role in a new company formed to commercialize their invention into a product.
- h. "Institution": The University of Rhode Island.
- i. "Intellectual Property" or "IP": Collectively, all forms of property created by the mind including, but not limited to, Inventions, Trade Secrets, Processes, Business and Technical Know-how, Copyrightable Works, Trademarks and Service Marks, and Tangible Research Property. Unless indicated otherwise, IP refers to properties owned by the BGHE or its designee.
- j. "Intellectual Property Disclosure": A written document that allows one skilled-in-the-art to fully understand and practice, apply and/or commercialize IP.
- k. "Intellectual Property Committee": A committee convened by the Institution under the guidance of its Vice President for DRED for purposes of reviewing and evaluating IP Disclosures.
- l. "Patent Protection Procedure": The procedure established under section III(g) for review of IP Disclosures by the Institution.
- m. "Invention": A process, method, discovery, device, plant, composition of matter, know-how, or other invention that reasonably appears to qualify for protection under United States patent law (including, but not limited to, utility patent, plant patent, design patent, certificate of Plant Variety Protection, etc.), whether or not actually patentable. This includes software that may also be a Copyrightable Work. An Invention may be the product of a single Inventor or a group of Inventors who have collaborated on a project.
- n. "Inventor": An individual who contributes to the conception of an Invention under U.S. patent law and who is identified as such on the licensed patent, patent application or unpatented technology. In the case of a patent or patent application, according to U.S. patent law, an Inventor's contribution must be applicable to at least one claim. For purposes of this Policy, wherever practicable, Inventor shall be deemed to include the estate of any deceased person who otherwise qualifies as an Inventor.
- o. "Licensing Revenue": Revenue derived from any agreement licensing or assigning IP rights to a third party in exchange for payment of licensing fees, research fees, milestone fees, sponsored research or development, royalties, equipment, equity, or like-in-kind payments. Licensing Revenue may be received by the Institution or URIRF.
- p. "Mediated Courseware": Teaching aids or instructional assets created and/or deployed electronically. Mediated Courseware may incorporate text, graphics,

video, and audio elements. Examples of such materials include, but are not limited to, hypertext modules, simulation software, web sites, and databases containing numbers, images, or text.


- q. "Public Disclosure": The description of an Invention in a printed publication, a patent application or at a conference, meeting, or other public gathering, in the United States or any other country, a sale or offer to sell an Invention, use of the Invention, other than as part of experimental use, in the United States, or disclosure to any person who is not required to maintain the Invention's confidentiality. A Public Disclosure is "enabling" when it permits a person having ordinary skill in the art to which it pertains to practice the Invention without undue experimentation.
- r. "Rhode Island Board of Governors for Higher Education" or "BGHE".
- s. "Significant Use of Institutional Resources": An Author's use of other employees' time or Institutional facilities or equipment that appreciably increases the Institution's costs beyond those normally incurred in support of an employee in the Institution. Significant Use does not include the normal use of Institutional employees' time, facilities, or equipment commonly available to faculty, staff, or the public, such as libraries, Internet access, office space, office equipment, computers, and/or office supplies, unless otherwise specified in a written agreement.
- t. "Tangible Research Property": Tangible items produced in the course of research including, but not limited to, such items as biological materials, engineering drawings, integrated circuit chips, computer databases, prototype devices, circuit diagrams, and equipment. Individual items of Tangible Research Property may be associated with one or more intangible properties, such as Inventions, Copyrightable Work, and Trademarks. An item of Tangible Research Property may be the product of a single Inventor or group of Inventors who have collaborated on the project.
- u. "Intellectual Property Management and Commercialization Office" or "IPMAC Office": The office having responsibility for the office of IP Management and Commercialization at the Institution or, where appropriate, its designee.
- v. "Trade Secret": Information, including a formula, pattern, compilation, program, device, method, technique or process, that derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use. *See also* Intellectual Property.
- w. "Trademark" (including Service Mark): A distinctive word, design, or graphic symbol, or combination word and design, that distinguishes and identifies the goods and services of one party from those of another, such as names or symbols used in conjunction with plant varieties or computer programs, or the Institutional names, logos, or derivatives thereof. *See also* Intellectual Property.
- x. "Vice President for Division of Research and Economic Development" or "VP

DRED": The individual holding the office of Vice President for Division of Research and Economic Development at the Institution or, where appropriate, his or her designee.

- y. "Work for Hire": Defined pursuant to federal Copyright Law which includes a Work prepared by employees (staff, faculty, or student) within the scope of their employment, or a Work created pursuant to a written agreement by third party identifying the Work as a Work for Hire. Unless a Copyright Agreement provides otherwise, software created by employees within the scope of their employment and not treated as Mediated Courseware under section IV of this Policy shall be treated as a Work for Hire.

MEMORANDUM

TO: Ray M. Di Pasquale, Commissioner
Rhode Island Office of Higher Education

FROM: David M. Dooley
President 

DATE: May 4, 2012

SUBJECT: University of Rhode Island Post Baccalaureate Certificate in Cyber Security and
the Revised Intellectual Property Policy

Enclosed is a Notice of Change for the Post Baccalaureate Certificate in Cyber Security, and the Revised Report of the URI Intellectual Property Policy. The proposal for the Post Baccalaureate Certificate in Cyber Security received approval by the College, Department, and the Graduate Council to the Faculty Senate. The Faculty Senate also approved the proposal on April 19, 2012 and I approved it on April 30, 2012. The Proposed Revised Intellectual Property Policy (as amended) received approval from all necessary Divisions and I approved it on April 30, 2012.

I look forward to a positive review and positive actions on the above items. Donald DeHayes, Provost and Vice President for Academic Affairs, will serve as the University's contact. Please feel free to contact him directly if you have any questions.

dr
enclosures

c: Deborah Grossman-Garber, Associate Commissioner, OHE
Donald H. DeHayes, Provost and Vice President for Academic Affairs
Laura Beauvais, Interim Vice Provost for Faculty Affairs
Dean Libutti, Vice Provost for Enrollment Management
Sheila Grubman, Faculty Senate Coordinator

UNIVERSITY OF RHODE ISLAND INTELLECTUAL PROPERTY POLICY

I. General Principles.

- a. The University of Rhode Island (hereinafter "Institution") encourages and promotes research and scholarship based on the traditional principles of the academic profession. Some discoveries, advancements, and innovative approaches may have the potential to be further developed into products or services that have utility beyond the Institution and that may positively impact the economy of Rhode Island. Through this Policy, the Institution seeks to define and execute a synergistic model of education, research, service, innovation, commercialization, and economic development and to apply this model to help solve significant problems of a complex world.
- b. The primary purposes of this Policy are to:
 1. Provide clear guidelines for all parties involved in the creation, development, management, protection, commercialization, licensing and dissemination of intellectual property.
 2. Provide for an effective, efficient process to achieve positive outcomes for creators, Colleges, Institution, and society.
 3. Recognize, respect, and effectively manage all interests that may emerge from discoveries that have commercial or other valued outcomes and provide guidance for intellectual property protection and commercial development.
 4. Bring technology into practical use for the public benefit as quickly and effectively as possible, in a manner consistent with applicable law and policy.
 5. Facilitate the creation of appropriate public-private partnerships in order to achieve commercialization, utilization, and economic development.
 6. Encourage a broad array of mutually beneficial relationships with organizations outside the Institution to further develop discoveries made at the Institution, including: collaborative research; licensing of Intellectual Property (IP); and the establishment of companies and other entities specifically formed to commercialize IP created at the Institution.
 7. Develop a process to work integrally with the URI Research Foundation (herein after URIRF) for the marketing and commercialization of Institution inventions and innovations and for fostering economic development in the State of Rhode Island.
- c. This Policy governs unless a specific policy or agreement provides otherwise.
- d. This Policy shall be administered in accordance with, and subject to, policies of the Institution concerning IP and its requirement under the Bayh-Dole Act and Federal and State Conflicts of Interest (COI), academic misconduct and other applicable laws and regulations.

- e. Any Creator of a Copyrightable Work, Invention, Trade Secret, Trademark, Tangible Research Property, or other IP should contact the Institution Office for Intellectual Property Management and Commercialization (IPMAC).

II. General Intellectual Property Policy.

- a. The Institution strongly encourages its faculty, staff, and others associated with the Institution to pursue formal protection and/or commercialization of all IP as a method of bringing recognition and/or remuneration to the Creators and the Institution.
- b. Intellectual Property may arise from the development of a new and useful process, device or apparatus, article of manufacture, design, composition of matter (including, but not limited to, a chemical compound, microorganism, nucleotide sequence, amino acid sequence, equipment, device, genetically engineered organism, and the like), plant, or related improvement, or a new use for a known material or device or related improvement. This class of IP will be considered as Patent IP, which includes patent applications and Plant Variety Protection. In addition, other intellectual property under the Copyright IP may include written material, spoken description, sketches, musical scores, sculptures, and paintings. Software code will be considered under Copyright IP and/or Patent IP. Trademarks will be considered separately under Trademarks IP. Any individual who is uncertain should contact the IPMAC Office and request guidance.
- c. Except as set forth herein, all rights to and interests in any IP resulting from research or investigation conducted in the course of the Creator's employment with the Institution (including, but not limited to, the performance of a grant, contract, or award made internally, by an extramural agency, or by a third party) or with the Creator's Significant Use of the Institution's Resources shall be the sole and exclusive property of the Board of Governors for Higher Education (BGHE) and its designee, unless specified otherwise by a prior written agreement. Unless approved by the Vice President for the Division of Research and Economic Development (DRED), no other person or entity shall have joint or shared rights of ownership or interest in such IP.
- d. Creator will provide any and all required declarations, assignments, and other documents in the course of processing IP.
- e. Unless otherwise provided by law or a prior written agreement, this Policy applies to any IP made by the Institution's faculty, staff, students, trainees, volunteers or others if such IP is the result of:
 - 1. Any IP developed by or under the direction of any faculty, staff, or student, the cost of which was partially or wholly paid for with funds under the control of or administered by the Institution; and/or
 - 2. Any IP developed by the faculty, staff, students, trainees, volunteers, or others utilizing the Institution's facilities, laboratories, or other resources available to such faculty, staff, students, trainees, volunteers or others

because of their status within the Institution.

III. Patent Intellectual Property Policy

- a. Patent IP is defined as Intellectual Property arising from the development of a new and useful process, device or apparatus, article of manufacture, design, composition of matter (including, but not limited to, a chemical compound, microorganism, nucleotide sequence, amino acid sequence, equipment, device, genetically engineered organism, and the like), plant, or related improvement, or a new use for a known material or device or related improvement, or a new use for a known material or device. Patent IP will include a patent application and Plant Variety Protection. A Creator of Patent IP will be considered an Inventor under Patent IP Policy.
- b. Patent IP conceived or developed in the furtherance of research or investigation conducted by the Institution's faculty, staff, students, trainees, volunteers, or others in section II(e) above, shall be promptly disclosed in writing to the IPMAC Office. After consultation with the IPMAC Office, the Inventor may be asked to complete and file an Invention Disclosure form provided by the IPMAC Office.
- c. All rights to and interests in any Patent IP arising in the course of research or investigation sponsored by the Institution, any government or private agency, or other sponsored research are controlled by the terms of the applicable IP agreement, which must be reviewed, negotiated, and approved by the IPMAC Office. In the absence of provisions to the contrary contained in any such research or investigation agreement or under federal law or regulations, the following shall apply:
 1. The Inventor has the right to:
 - i. Receive notice of the Institution's intention to protect Patent IP or otherwise to retain title to the IP after the IP Disclosure is made to the Institution within six (6) months or as otherwise prescribed by laws;
 - ii. Receive a share of any Licensing Revenue, such as licensing fees or royalties, received by the Institution from the commercialization of the Invention according to the appropriate Distribution Schedule contained under this section; and
 - iii. Receive from the Institution title to any Patent IP subject to this Policy in the event the Institution elects not to retain the same.
 2. The Inventor is required to:
 - i. Promptly file an IP Disclosure including the name of any co-Inventor;
 - ii. Assign ownership of the Patent IP to the BGHE and its designee;
 - iii. Cooperate to the extent necessary as determined by the Institution in the reasonable delay of publication to allow for a timely submission of a patent application;

- iv. Cooperate in protecting any Patent IP;
 - v. Participate in the defense of such patents during prosecution for interference or infringement; and
 - vi. Assist with licensing or marketing efforts related to the Patent IP.
3. The BGHE and its designee has the right to:
- i. Assign its rights to the Inventor, up to and including full ownership, in any Patent IP subject to this Policy to which the BGHE and its designee choose not to retain title;
 - ii. Assign at any time by the President, or designee, the rights or interests of any Patent IP owned by the BGHE and its designee to an Affiliated Foundation whereby the URIRF is the sole Affiliated Foundation recognized to receive Patent IP; or
 - iii. Retain non-commercial research rights to any Patent IP developed by the Institution.
4. The Institution is obligated to:
- i. Provide adequate resources to fulfill and meet the obligations in the Patent IP Policy and comply with the Bayh-Dole Act and other applicable laws;
 - ii. Make faculty, staff, students, trainees, volunteers or others aware of the Patent IP Policy and of any ongoing agreements with external sources to evaluate and/or market such IP;
 - iii. Determine, after the IP Disclosure is filed, whether the Institution chooses to retain title and to protect the Patent IP and give notice of Institution's intention to protect the Patent IP to the Inventor within six (6) months or as otherwise prescribed by laws;
 - iv. Expedite formal Patent IP protection procedures; and
 - v. Distribute Licensing Revenue received by the Institution for any Patent IP according to the appropriate Distribution Schedule contained herein.
- d. The distribution of royalties and other licensing revenue, such as licensing fees, milestone payments or equity, received by the Institution or URIRF for exclusive licenses or assignments shall be distributed according to the following considerations. There are numerous interests involved in connection with research and innovation performed at the Institution, including the researcher and Inventor; the Institution; the general public whose taxes and gifts support the Institution; and outside entities that provide support. Subject to restrictions arising from obligations of the Institution or URIRF pursuant to gifts, grants, contracts, or other agreements with outside organizations, the Institution or URIRF agrees, for and in consideration of the licensing or assignment of Patent IP rights, to pay Cumulative Net Royalties according to the Distribution Schedule below for Patent IP licensed or assigned by the Institution or URIRF.

Patent IP Distribution Schedule

Cumulative Net Royalties	Inventor	College	URIRF
\$25,000 or less	40.0 %	30.0 %	30.0 %
Above \$25,000	35.0 %	32.5 %	32.5 %

When there are two or more Inventors, each Inventor shall share equally in the Inventor's share of Cumulative Net Royalties, unless all Inventors have agreed in writing to a different distribution of such share. Likewise, where there are two or more Colleges involved, each College shall share equally unless otherwise agreed in writing. The VP DRED shall have final authority in resolving disputes between Inventors and Colleges as to the sharing of royalties between them.

- e. Cumulative Net Royalties received by the URIRF and the Colleges must be used to support research and to further the development, commercialization and/or protection of any IP. To this end, Institution shall reward its employees for creating Patent IP and participating in commercialization activities, assist faculty and staff in the commercialization of their products, support related programs, support additional research in the laboratories and programs that generated the Patent IP, and support the protection of new discoveries.
- f. The Inventor obligations under section III(c)(2) and Institution obligations under section III(c)(4) do not terminate upon separation of employment from the Institution.
- g. Intellectual Property Protection Procedure. Unless otherwise indicated, the VP DRED, or designee, is responsible for the administration of this Policy. The IPMAC Office is responsible for the administration of the Patent Protection Procedure, the oversight of financial rights, negotiations and for management of Patent IP records. This Patent Protection Procedure serves as a guide to the Institution community in meeting the disclosure and reporting requirements of the Institution, BGHE, and cooperating agencies.
 - 1. Intellectual Property Agreement Review. Prior to executing any contract that binds the Institution or one or more Inventors with regards to Patent IP, such contract will be submitted to the IPMAC Office, who may consult with the Institution General Counsel, to ascertain that IP clauses in sponsored projects are acceptable to the principal investigator and the Institution and are consistent with policies of the BGHE, and if appropriate, with federal law. Such agreements include confidentiality, non-disclosure, material transaction, consulting, and like agreements containing provisions for proprietary information and contractor sponsored research or development, licensing, or like agreements containing provisions for any Patent IP.
 - 2. Documentation and Tracking. Inventors are responsible for recording and maintaining the discovery records of all potentially patentable discoveries derived through Institution activity. Subject to America Invents Act effective

March 16, 2013, bound, dated, witnessed documentation is the encouraged method for maintaining such records. Inventors shall discuss with the IPMAC Office the proper method for maintaining records.

3. **Intellectual Property Disclosure.** An Inventor shall meet with the IPMAC Office and disclose the actual or prospective Patent IP at the earliest possible time after its creation. After consultation with IMPAC Office, the Inventor may be asked to complete and submit an Invention Disclosure describing the Invention. In the case of Inventions, the Inventor is encouraged to submit an IP Disclosure to the Institution at least ninety (90) days prior to any enabling Public Disclosure. An Invention Disclosure should be made on a form provided by the IPMAC Office or prepared in conjunction with the IPMAC Office. If the Invention Disclosure is deemed adequate, the IPMAC Office will assign a unique Institution identifier. The IPMAC Office will have sole discretion to determine whether the IP Disclosure is sufficient. If not on file, the Inventor shall assign ownership rights to BGHE and its designee. Upon receipt of an Invention Disclosure, the IPMAC Office will notify within a reasonable period of time, if necessary, the appropriate federal agency providing grant support of the Disclosure, in compliance with 37 CFR Part 401 and 35 U.S.C. sections 200-212.
4. **IPMAC Office Evaluation.** The IPMAC Office will review each Invention Disclosure before committing Institution resources or other funds in the pursuit of a patent, protection of a trade secret, protection of copyright or any other form of protection of any IP. Such an evaluation should consider all aspects of any IP, prior art search and assessment, market potential, prospective licensees, financial return, obligations to sponsoring parties, and other factors impacting the investment of time and funds to complete the IP protection process. This review may entail the commissioning of market, patentability, or similar studies at the sole discretion of the IPMAC Office. Upon review, the IPMAC Office will advance Invention Disclosure to the IP Committee for review, unless additional research or investigation is required.
5. **Intellectual Property Committee Review.** The IP Committee will review the Patent IP with the Inventor and make one of three recommendations. If necessary, the IPC will prioritize the filing patent applications in the case of an Invention. The three recommendations are: accept to protect IP; provisional acceptance pending additional work or review of prior art; or return rights to the Inventor.
6. **Notification of the College.** The recommendation of the IPC will be submitted to the Dean of the Inventor College for their review. The Dean may agree with the recommendation or disagree with the recommendation. If the Dean disagrees with the recommendation to protect the Patent IP, then the URIRF may pay for all the Patent IP costs and the Colleges will not receive any royalty distribution. If the Dean disagrees with returning the IP rights to the Inventor, then the College may be responsible for all IP costs, unless the URIRF agrees to share 50% of the IP costs with the College. In

the case where the College pays all patent costs, it will receive the URIRF Cumulative Net Royalties share.

7. Final approval by the VP DRED. Upon determination that Institution will not pursue protection of IP, and no later than six (6) months after receipt of the Invention Disclosure all rights in the IP will be returned to the Inventor. Institution shall execute one or more assignments to the Inventor to effect this reversion.
8. Patent IP Application. Upon approval by the Institution to pursue protection of an Invention, the IPMAC Office will:
 - i. Notify, if necessary, the appropriate federal agency of the Institution's desire to retain title to the invention;
 - ii. Work with Inventor to file a patent application or PVP on the Invention; and
 - iii. File a patent application either directly or with an external service provider within the appropriate period.
9. Intellectual Property Costs. The Institution shall be responsible to pay an annual amount toward the total annual cost of Patent IP protection and maintenance. For Patent IP costs greater than the Institution annual allocation, URIRF and the Colleges will equally share the costs for the year as follows. In a fiscal year, Colleges having 5 or more patent applications in prosecution or issued patents will pay at rate of 1 unit. Colleges having 1-4 patent applications in prosecution or issued patents will pay at rate of 0.2 unit. College share for the fiscal year will be determined by dividing their unit by the sum of all units in that year times one-half of the unpaid Patent IP costs.
10. Documentation. As necessary to protect the interests of the Inventor and the Institution, and as allowed by law, the records supporting IP protection and appropriate documents with any commercialization organization will be maintained as confidential. The official IP file shall contain the following items, if applicable:
 - i. Documentation identifying the sources of funds used to cover costs.
 - ii. The costs of Patent IP protection and maintenance. In the event that third party reimbursed for prosecution or related IP costs, Institution's costs will be reduced accordingly.
 - iii. Contract or grant terms and conditions under which the IP was conceived or developed.
 - iv. Initial records of invention (i.e. notebook references, drawings, sketches, etc.) and formal records of invention required by sponsors.
 - v. IP Disclosure documents submitted by the Inventor.
 - vi. Assignments and other agreements relating to the transfer of ownership.

- vii. Documentation of the recommendation of the IPC and the written notice by the VP DRED to either protect the Patent IP rights or to return the Patent IP rights to the Inventor and the cost of Patent IP protection.
 - ix. Patent IP application(s), as filed.
 - x. Any agreements related to the licensing of the Patent IP rights.
 - xi. Issued or registered Patent IP rights.
 - xii. Licenses, equity positions, or other commercialization documents or agreements that specify the financial returns to the Institution or URIRF.
 - xiii. Documentation reflecting abandonment of any Patent IP by the Institution, as well as any agreements transferring title back to the Inventor.
11. Commercialization. Upon the decision to pursue commercialization of Patent IP, the IPMAC Office or URIRF shall outline a commercialization plan in cooperation with the Inventor. The commercialization may include licensing to a company including licensing to a company started by the Inventor.
12. Intellectual Property Assignment and/or Licensing. At any time subsequent to the disclosure of Patent IP to BGHE or its designee, the rights, title and/or interest therein may be licensed or assigned to one or more third parties. In the case of assignments, only the President of the Institution, or a designee, may sign appropriate documentation affecting the same.
- i. The Institution authorizes the IPMAC Office to establish a means of administering and managing the Institution's Patent IP assets that (1) expedite their commercialization, (2) provide means for the defense of Patent IP, (3) maintain the secrecy of Patent IP when necessary, and (4) provide financial returns to the Inventor and the Institution. For commercialization of Patent IP not assigned to URIRF, the IPMAC Office will be responsible for negotiating and approving all agreements relating to the assignment of Patent IP rights. Authority to sign licensing or like agreements on behalf of the Institution shall be vested in the IPMAC Officer and the VP DRED, and their designees.
 - ii. At its sole discretion, the BGHE or designee may assign or transfer ownership rights in Patent IP to the URIRF, in which case URIRF will assume obligations under this section III, as appropriate, and provide timely documentation to the Institution in addition to complying with any formal agreement between the Institution and the URIRF.
 - A. The URIRF may request that the BGHE or designee transfer specific Patent IP rights for patenting and commercialization activities. Such a request should be in writing and made to the IPMAC Office.
 - B. When appropriate, Institution and URIRF will have confidentiality agreements to cover the exchange of information.

- C. If the Patent IP was supported directly or indirectly by a federal agency, prior to assignment the Institution will obtain documents showing that the Patent IP has been assigned to the BGHE or designee by the Inventor and the Institution has disclosed and elected to retain title therein to the supporting agency.
 - D. If URIRF funds commercialization, product development, and/or research at the Institution for the advancement of Patent IP, the Institution shall not charge any indirect cost rate unless agreed otherwise.
 - F. Upon transfer of Patent IP to an URIRF, Institution will provide copies of all Patent IP documents to the URIRF, including original file wrappers, agreements, and related documents.
 - G. When the BGHE or designee has transferred Patent IP to an URIRF, subject to restrictions arising from obligations of the Institution pursuant to gifts, grants, contracts, or other agreements with outside organizations, URIRF will, for and in consideration of the assignment of Patent IP rights, pay Cumulative Net Royalties under the Distribution Schedule III(c):
- iii. It is the responsibility of the employee and College to provide the IPMAC Office or URIRF with any and all relevant IP agreements, which include consulting, confidentiality, MTA, licensing and research agreements, to ensure that the term of the agreement with third parties do not conflict with their commitment to the Institution. Each employee shall make the nature of the employee's obligations to the Institution clear to any third party for whom the employee expects to consult. Specifically, the scope of the consulting service must be distinguished from the scope of research commitment to the Institution. This subsection shall comply with and be subject to any Federal, State or Institutional laws or policies regarding Conflict of Interest.
13. Formation of New Company with Inventor as an Owner. After transferring rights to the URIRF, the URIRF may license or assign, if the assignment has been transferred, the IP rights to the New Company owned by the Inventor in exchange for licensing fees and royalty or an equity share in the New Company.
- i. The Inventor will be required to undergo a Conflict of Interest evaluation by the Institution and, if necessary, receive approval by the BGHE.
 - ii. In the case where URIRF has an equity share in the New Company, URIRF share will be at least 10% unless agreed otherwise.
 - iii. The Inventor will be allowed to choose between an equity ownership of the Company or their Distribution Share of the Cumulative Net Royalties received from the New Company but not both. In the event that Inventor forgoes receiving their Distribution Share of the Cumulative Net Royalties, URIRF and the College will receive 50% of Cumulative Net

Royalties.

14. **Cumulative Net Royalties Distribution.** Unless assigned to an URIRF, the IPMAC Office will be responsible for the collection of all Licensing Revenue and the payment of all Costs of Patent IP Protection and the distribution of Cumulative Net Royalties under section III(d) upon approval by the VP DRED. In the case of IP assigned to URIRF, URIRF will distribute Cumulative Net Royalties as set forth in under section III(d). Documentation of the distribution of licensing revenue to the Inventor, Institution, any cooperating agencies, and other parties will be provided upon request by the IPMAC Office or URIRF.
15. **Intellectual Property Documents.** The IPMAC Office shall maintain a filing and storage system for all original Patent IP documents and any and all IP agreements that is consistent with Institution's record retention policy.
16. **URIRF may not enter into an agreement to sell, transfer, or otherwise dispose of any ownership rights in Patent IP to any third party without the express, written permission of the President of the Institution or BGHE, unless IP rights have been transferred to URIRF. Any request for such permission shall include, at a minimum, a comprehensive description of the asset to be transferred, the identity of the proposed transferee, a statement of the purpose of the proposed transaction, and a statement of the benefit to the Institution to be derived from the proposed transaction.**

IV. *Copyright Intellectual Property Policy.*

- a. Except as otherwise explicitly provided under this Policy or a Copyright Agreement, an employee who creates a Work shall be deemed to acquire copyright ownership of the Work, unless Significant Use of Institutional Resources is made. Under the Copyright IP Policy, Works may include written material, software, code spoken description, sketches, musical scores, sculptures, and paintings and a Creator of the Work will be considered an Author. In keeping with this Policy and with academic custom, except as otherwise provided under this Policy, the Institution shall forever disclaim its copyright ownership in a Work for Hire in favor of the Author, and when deemed necessary, the BGHE or its designee shall execute one or more assignments conveying such copyright ownership to such Author.
- b. Copyright ownership of Work developed as a result of Work supported partially or fully by an outside agency through a contract or grant shall be determined in accordance with the terms of the contract or grant. In those cases in which copyright ownership is vested in the BGHE or its designee, the Institution shall have the first option to secure copyright in the name of the Institution. Should the Institution decide, in writing, not to secure copyright, the employee then may proceed to personally secure the copyright. The BGHE or its designee shall then execute one or more assignments conveying such copyright ownership to such Author.

- c. **Self-initiated Mediated Courseware.** When an employee develops Mediated Courseware without specific direction by the Institution, unless otherwise agreed, the ownership of copyright in the Mediated Courseware shall be deemed to vest in the employee. In the case that such Mediated Courseware is a Work for Hire by a third party, the Institution shall forever disclaim its copyright ownership in favor of the Author, and when necessary, the BGHE or its designee shall execute one or more assignments conveying such copyright ownership to such Author. Normally, no royalty, rent, or other consideration shall be paid to the employee when that Mediated Courseware is used for instruction at the Institution and such Mediated Courseware shall not be used or modified without the consent of the employee. While the Author is employed by the Institution, the Mediated Courseware shall not be sold, leased, rented or otherwise used in a manner that competes in a substantial way with the for-credit offering of the Institution unless approved by the Provost for Academic Affairs of the Institution. The Institution shall have a perpetual, non-exclusive, royalty-free right to use such courseware for archival research purposes. In the event that Significant Use of Institution Resources are used to develop or improve Mediated Courseware, the Author shall be required to obtain approval to use the Mediated Courseware outside of the Institution and the provisions of section IV(b) of this Policy shall apply.
- d. **Institution-directed Mediated Courseware.** When the Institution directs in a written employment contract or Copyright Agreement the creation of specific Mediated Courseware, copyright in the resulting Mediated Courseware belongs to the BGHE or its designee and the Institution shall have the exclusive right to revise it and decide who will utilize the Mediated Courseware in instruction. Pursuant to this subsection, insofar as the Mediated Courseware is a Work for Hire, the BGHE or its designee shall retain copyright ownership. Development of Institution-directed Mediated Courseware shall be reported to appropriate administrator(s) at the Institution.
- e. Unless otherwise specified by this Policy, the Licensing Revenue received in excess of \$10,000 as a result of copyright ownership by the BGHE or its designee will be disbursed as follows; 60% to the Author, 20% to the College and 20% to URIRF.
- f. When the Author creates a Work involving Significant Use of Institutional Resources and if the Licensing Revenue is in excess of \$10,000, the following steps should be followed to determine Copyright Ownership between the Author and the BGHE or its designee:
 - 1. The Author will initiate the process by delivering a copy of the Work and complete and submit the completed Intellectual Property Disclosure to the IPMAC Office.
 - 2. The IPC will make a recommendation regarding Copyright ownership to VP DRED.
 - 3. If the BGHE or its designee has Copyright ownership, then a Copyright Agreement will be entered into between the Author and the VP DRED on

behalf of the Institution or URIRF.

- i. Only if requested, Institution shall be responsible for copyright registration of Work owned by the BGHE or its designee, and for administering contracts with its Author, including the responsibilities associated with maintaining records for copyright registration, royalty collection and distribution, marketing, and such other actions as are appropriate. Institution and Author shall cooperate in the pursuit of copyright protection.
- ii. In all other cases, Author will assume the responsibilities associated with maintaining records for copyright registration, royalty collection, marketing, and such other actions as are appropriate.

V. *Trademark Intellectual Property Policy*

- a. The URIRF or BGHE or its designee shall be listed as the owner of any trademark or service mark for which an application for registration is filed, unless an agreement is to the contrary. Trademarks and service marks shall be filed, prosecuted, registered, and maintained by the Institution at the Institution's expense.
- b. URIRF's or Institution's preference will be to secure federal trademark and service mark registrations, but the Institution reserves the right to secure one or more state registrations.
- c. URIRF or BGHE or its designee may license to a third-party rights in one or more trademarks or service marks owned by or BGHE or its designee. Any such license must at minimum reserve to the URIRF or Institution, the express right to monitor and supervise the use of the mark by licensee.
- d. Trademarks developed by faculty, students, staff or others of the Institution shall, where practicable, be treated in the same manner as other forms of IP. In order to be recognized as a Creator of a trademark, one or more faculty members, students, or staff or others must submit a written statement of creation to the IPMAC Office, preferably before the mark is first used by the Institution but no later than six (6) months after an application to register the mark is filed by Institution. A statement of creation must set forth the identity and contact information of each Creator, a detailed description of the mark, the circumstances of the creation, and the goods and/or services of Institution to which the mark applies or could apply. A separate statement must be submitted for each mark.
- e. Revenue generated through commercialization of goods or services, including technology, under one or more trademarks owned by the BGHE or its designee that is attributable solely to such trademark(s), such as trademark licensing fees and royalties, shall be deemed Cumulative Net Royalties and distributed under the Copyright Intellectual Property Policy, IV(e), for purposes of this Policy.
- f. In no instance, and regardless of ownership, may the Institution's Trademarks or identity be used, expressly or impliedly, in connection with the endorsement

of any Trademark IP. For purposes of this sub-section, "identity" shall include full or partial names or identifiers, physical addresses, Internet or web addresses, trademarks, service marks, logos, emblems or seals. Assignments, license agreements, and other transfers of rights or ownership in any Trademark IP to third parties shall include this limitation.

VI. Definitions.

- a. "Affiliated Foundation": An Affiliated Foundation is a third party organized as a nonprofit entity as described in section 501(c)(3) of the Internal Revenue Code of 1986, that has as one of its primary functions the management of Institution IP and that receives Licensing Revenue and gifts, and supports or promotes the Institution or Institution research under 37 CFR Part 401 and 35 U.S.C. sections 200-212. URI Research Foundation (hereinafter "URIRF") is the sole Affiliated Foundation, unless deemed otherwise by BGHE or its designee.
- b. "Author": A person who creates a Copyrightable Work.
- c. "Copyright Agreement": A written and signed agreement between the Author and the Institution that explicitly defines: the ownership of the Copyrightable Work, any control rights in cases of Mediated Courseware, any reimbursement for Significant Use of Institutional Resources, and/or the sharing of royalties.
- d. "Copyrightable Work" or "Work": An original Work by an Author which has been fixed in a tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device, such as books, journals, software, computer programs (including source code), musical Work, dramatic Work, videos, multimedia products, sound recordings, pictorial and graphical Work, etc. Any Copyrightable Work that is also an Invention shall be governed by the Patent Intellectual Property Policy. A Work may be the product of a single Author or a group of Authors who have collaborated on a project. See *also* Intellectual Property.
- e. "Costs of IP Protection": The expenses incurred by the Institution in conducting the research and in procuring, protecting, preserving, maintaining, and licensing IP and related rights. This includes the costs of securing patent, copyright, or trademark protection in the United States and any foreign jurisdiction.
- f. "Creator": A person who contributes to the development of IP at the Institution in a significant manner and who under this Policy is entitled to the distribution of proceeds from commercialization. For purposes of this Policy, wherever practicable, Creator shall be deemed to include the estate of any deceased person.
- g. "Cumulative Net Royalties": The cumulative lifetime gross revenues obtained from royalties, licensing or assignment fees, and/or the proceeds from the sale of equity, and/or the direct proceeds from Institution practicing its own IP, less external expenses incurred by the Institution or URIRF in procuring, protecting, preserving, and maintaining IP rights, including legal fees associated with the

IP, fees for patentability searches, fees arising out of litigation, fees for legal advice, or any fees or costs directly attributable to the IP being licensed. Marketing and indirect costs, overhead, or other Institution costs usually associated with operation of the Institution and not directly attributable to the IP will not be deducted from gross revenues.

- h. "Entrepreneurial Leave". A Creator may request entrepreneurial leave to pursue their leadership role in a new company formed to commercialize their invention into a product.
- h. "Institution": The University of Rhode Island.
- i. "Intellectual Property" or "IP": Collectively, all forms of property created by the mind including, but not limited to, Inventions, Trade Secrets, Processes, Business and Technical Know-how, Copyrightable Works, Trademarks and Service Marks, and Tangible Research Property. Unless indicated otherwise, IP refers to properties owned by the BGHE or its designee.
- j. "Intellectual Property Disclosure": A written document that allows one skilled-in-the-art to fully understand and practice, apply and/or commercialize IP.
- k. "Intellectual Property Committee": A committee convened by the Institution under the guidance of its Vice President for DRED for purposes of reviewing and evaluating IP Disclosures.
- l. "Patent Protection Procedure": The procedure established under section III(g) for review of IP Disclosures by the Institution.
- m. "Invention": A process, method, discovery, device, plant, composition of matter, know-how, or other invention that reasonably appears to qualify for protection under United States patent law (including, but not limited to, utility patent, plant patent, design patent, certificate of Plant Variety Protection, etc.), whether or not actually patentable. This includes software that may also be a Copyrightable Work. An Invention may be the product of a single Inventor or a group of Inventors who have collaborated on a project.
- n. "Inventor": An individual who contributes to the conception of an Invention under U.S. patent law and who is identified as such on the licensed patent, patent application or unpatented technology. In the case of a patent or patent application, according to U.S. patent law, an Inventor's contribution must be applicable to at least one claim. For purposes of this Policy, wherever practicable, Inventor shall be deemed to include the estate of any deceased person who otherwise qualifies as an Inventor.
- o. "Licensing Revenue": Revenue derived from any agreement licensing or assigning IP rights to a third party in exchange for payment of licensing fees, research fees, milestone fees, sponsored research or development, royalties, equipment, equity, or like-in-kind payments. Licensing Revenue may be received by the Institution or URIRF.
- p. "Mediated Courseware": Teaching aids or instructional assets created and/or deployed electronically. Mediated Courseware may incorporate text, graphics,

video, and audio elements. Examples of such materials include, but are not limited to, hypertext modules, simulation software, web sites, and databases containing numbers, images, or text.

- q. "Public Disclosure": The description of an Invention in a printed publication, a patent application or at a conference, meeting, or other public gathering, in the United States or any other country, a sale or offer to sell an Invention, use of the Invention, other than as part of experimental use, in the United States, or disclosure to any person who is not required to maintain the Invention's confidentiality. A Public Disclosure is "enabling" when it permits a person having ordinary skill in the art to which it pertains to practice the Invention without undue experimentation.
- r. "Rhode Island Board of Governors for Higher Education" or "BGHE".
- s. "Significant Use of Institutional Resources": An Author's use of other employees' time or Institutional facilities or equipment that appreciably increases the Institution's costs beyond those normally incurred in support of an employee in the Institution. Significant Use does not include the normal use of Institutional employees' time, facilities, or equipment commonly available to faculty, staff, or the public, such as libraries, Internet access, office space, office equipment, computers, and/or office supplies, unless otherwise specified in a written agreement.
- t. "Tangible Research Property": Tangible items produced in the course of research including, but not limited to, such items as biological materials, engineering drawings, integrated circuit chips, computer databases, prototype devices, circuit diagrams, and equipment. Individual items of Tangible Research Property may be associated with one or more intangible properties, such as Inventions, Copyrightable Work, and Trademarks. An item of Tangible Research Property may be the product of a single Inventor or group of Inventors who have collaborated on the project.
- u. "Intellectual Property Management and Commercialization Office" or "IPMAC Office": The office having responsibility for the office of IP Management and Commercialization at the Institution or, where appropriate, its designee.
- v. "Trade Secret": Information, including a formula, pattern, compilation, program, device, method, technique or process, that derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use. See *also* Intellectual Property.
- w. "Trademark" (including Service Mark): A distinctive word, design, or graphic symbol, or combination word and design, that distinguishes and identifies the goods and services of one party from those of another, such as names or symbols used in conjunction with plant varieties or computer programs, or the Institutional names, logos, or derivatives thereof. See *also* Intellectual Property.
- x. "Vice President for Division of Research and Economic Development" or "VP

DRED”: The individual holding the office of Vice President for Division of Research and Economic Development at the Institution or, where appropriate, his or her designee.

- y. “Work for Hire”: Defined pursuant to federal Copyright Law which includes a Work prepared by employees (staff, faculty, or student) within the scope of their employment, or a Work created pursuant to a written agreement by third party identifying the Work as a Work for Hire. Unless a Copyright Agreement provides otherwise, software created by employees within the scope of their employment and not treated as Mediated Courseware under section IV of this Policy shall be treated as a Work for Hire.